

REMARKS

Reconsideration of the application as amended is respectfully requested. In the Office Action, the Examiner rejected claims 19-25. By the present Response, Applicants cancel claims 20 and 24, amend claims 19 and 23, and add new claims 26-40. Applicants respectfully assert that no new matter has been added, as the new claims recite subject matter previously claimed in the original claims. Upon entry of the amendments, claims 19, 21-23, and 25-40 will be pending in the present application. In view of the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 19-25 under 35 U.S.C. § 102(b) as anticipated by various references. However, as discussed below, Applicants respectfully assert that the pending claims, as amended, are not anticipated. In particular, the Chiou reference (U.S. Patent No. 5,828,553; hereinafter “Chiou”) does not disclose all of the features recited in the instant claims. Furthermore, the claimed invention antedates the Chen reference (U.S. Patent No. 6,665,177; hereinafter “Chen”) relied upon by the Examiner.

Legal Precedent

First, Applicants respectfully remind the Examiner that, during patent examination, the pending claims must be given an interpretation that is reasonable and consistent with the specification. *See In re Prater*, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); *see also In re Morris*, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); M.P.E.P. §§ 608.01(o) and 2111. In other words, “[c]laims are not to be read in a vacuum, and limitations there are to be interpreted in light of the specification in giving them ‘their broadest reasonable interpretation.’” *In re Marosi*, 218 U.S.P.Q. 289, 292 (Fed. Cir. 1983) (emphasis on original). Moreover, interpretation of the claims must also be consistent

with the interpretation that those skilled in the art would reach. *See In re Cortright*, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); *see also* M.P.E.P. § 2111

Secondly, Applicants respectfully emphasize that anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). To maintain a proper rejection under Section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

First Section 102 Rejection

In the Office Action, the Examiner rejected claims 19-21 and 23-25 under 35 U.S.C. § 102(e) as being clearly anticipated by Chen. Applicants respectfully traverse this rejection. In short, Applicants respectfully assert that the submitted Rule 131 Declarations and their corresponding exhibit establish, with a sufficient showing of facts, that the presently claimed subject matter was *conceived and reduced to practice prior to* the earliest possible effective date of Chen, which, as discussed further below, is September 21, 2001. Thus, Applicants antedate Chen. Accordingly, Applicants respectfully request Chen be removed from consideration.

Legal Requirements for a Rule 131 Declaration

To establish prior invention, an applicant must present a “showing of facts [that] shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of

the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.” 37 C.F.R. § 1.131(b). Thus, an applicant can antedate a cited reference by demonstrating an actual reduction to practice prior to the earliest possible effective date of the cited reference, and this demonstration stands on its own. To establish actual reduction to practice of the claimed invention, an applicant must show that the apparatus actually existed and worked for its intended purpose. See M.P.E.P. § 715.07(III). However, the Federal Circuit acknowledges that there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice. See *In re Ashai/America Inc.*, 637 U.S.P.Q.2d 1204, 1206 (Fed. Cir. 1995).

Furthermore, with respect to the required “facts,” the M.P.E.P. states that “when reviewing a 37 C.F.R. 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and ‘notes.’ ” See M.P.E.P. § 715.07(I). Moreover, “an accompanying exhibit need not support all of the claimed limitations but rather a missing feature may be supplied by the declaration itself.” *Ex parte Ovshinsky*, 10 U.S.P.Q.2d 1075, 1077 (PTO Bd. App. 1989) (citing *Ex parte Swaney*, 89 U.S.P.Q. 618 (PTO Bd. App. 1950)). Indeed, “it is entirely appropriate for [an applicant] to rely on a showing of facts set forth in the Rule 131 declarations themselves to establish conception of the invention prior to the effective date of the reference.” *Id.*

Earliest Effective Date of Chen

Chen, on its face, presents a filing date of September 21, 2001, and has no claim of priority. *See Chen*, p. 1. Accordingly, the earliest possible effective date of Chen is this September 21, 2001, filing date.

The Claimed Subject Matter Antedates Chen

As provided in Paragraph 3 of the Declarations of Gregory C. Franke, Donald J. Hall, and Jeffrey A. Lambert (hereinafter “the Franke et al. Declarations”), inventors of record Gregory C. Franke, Donald J. Hall, and Jeffrey A. Lambert declare that the claimed subject matter of the above-referenced patent application was conceived prior to September 21, 2001, the earliest possible effective date of Chen. This conception is evidenced by a copy of a photograph of a clip as recited in the pending claims, which was actually reduced to practice prior to September 21, 2001, and is labeled Exhibit “A.”

As indicated by paragraph 4 of the Franke et al. Declarations, Gregory C. Franke, Donald J. Hall, and Jeffrey A. Lambert, inventors of record, declare that the invention disclosed and presently claimed in the instant application was actually reduced to practice prior to September 21, 2001. As noted above, this reduction to practice is evidenced by Exhibit “A.”

In view of the foregoing remarks, the accompanying Declaration, and the supporting exhibit submitted herewith, Applicants respectfully request that the Examiner remove Chen from consideration and allow claims 19, 21, 23, and 25.

Second Section 102 rejection

In the Office Action, the Examiner rejected claims 1 and 22 under 35 U.S.C. 102(e) as anticipated by Chiou. In rejected these claims, the Examiner stated:

Claims 1 and 22 are rejected under 35. U.S.C. 102(e) as being anticipated by Chiou, 5828553. Chiou discloses a heatsink retaining clip (figure 1) designed to secure a heatsink to a heat sink retainer comprising:

- A body portion (3)
- A first retaining arm (21) having a first window cutout (211)

- A second retaining arm (11) having a second window cutout (111)
- A disengagement arm (12)
- A cam arm (4) having a lock (411)

Office Action mailed March 18, 2005, p. 2.

Claim 1 is cancelled, so the Examiner's reference to claim 1 is assumed to refer to claim 19. Applicants have amended claim 19 to clarify the intended subject matter. Applicants respectfully assert that the subject matter of claim 19, as amended, is not disclosed by Chiou. In particular, Chiou appears to disclose a clip in which the body portion laterally slides to engage and disengage the return arms. *See* Chiou, col. 2, lines 28-52; FIGS. 2-4. Conversely, the claimed subject matter recites a body portion that is configured to bend, not laterally slide, to achieve separation of the retaining arms.

Thus, Applicants respectfully assert that Chiou does not disclose all of the features recited in independent claim 19 or dependent claim 22. Accordingly, Applicants respectfully assert that no *prima facie* case of anticipation exists with regard to independent claim 19 or dependent claim 22. With the foregoing in mind, Applicants respectfully request reconsideration and allowance of claims 19 and 22.

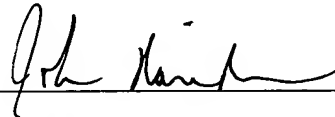
New Claims

As noted above, Applicants add new claims 26-40 to clarify certain aspects of the claimed subject matter. Respectfully, Applicants assert that the cited references do not anticipate these new claims. Therefore, Applicants respectfully request allowance of new claims 26-40. New independent claim 28 recites features similar to those recited in original claim 24, which the Examiner did not indicate as present in the Chiou reference. Likewise, new independent claim 35 recites features similar to those recited in original claim 20, which the Examiner did not indicate as present in the Chiou reference.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "John Rariden", is written over a horizontal line.

Date: June 10, 2005

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